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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,437	06/21/2001	Stephan Alan Cohen	YOR920000772US1	5757

7590 08/27/2003

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EXAMINER

KITOV, ZEEV

ART UNIT

PAPER NUMBER

2836

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,437

Applicant(s)

COHEN ET AL.

Examiner

Zeev Kitov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examiner acknowledges a submission of the arguments filed on June 16, 2003. Applicant's arguments have been fully considered but they are not persuasive, see Response to Arguments below. Claims 1 – 15 remain rejected.

2. Drawings

a) New corrected drawings are required in this application because submitted drawings are informal and hard to understand. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

b) The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: element 2 in Fig. 4 is not described in the Specification.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: element 25 in Fig. 5 is not shown. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. Objections

Examiner agrees with the Applicant regarding Objections indicated in a Previous Office Action. Accordingly, objection to a term "a nondestructive unlimited current" in Claims 1 and 9 and to the term "unimpeded" in lines 14 and 16 on page 4 are withdrawn. Objection to Claim 14 due to the term "over voltage" is withdrawn as well.

4. Application status

Claims 1, 5, 9 and 10 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 6.

Claims 2 – 4, 6 – 8, 11 – 15 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No.6.

5. Response to Arguments

In his response an Applicant suggests that the breakdown physics at field strength of about 2 MV/cm is different from what is known from textbooks and papers available to one of ordinary skill in the art. The Applicant further challenges an Examiner to disprove his assertion saying: "It is unclear how the Zandman formula (page 250) could be applied to any thickness ranges such as to support an assertion of applicability to any thickness" (page 2, lines 10 – 12). In response, the Examiner should remind the Applicant that the USPTO is not a scientific, neither a research body. It is not a duty of Examiner to disprove the Applicant scientific assertions. A burden of proof is on the Applicant's side to demonstrate that his assertions are valid. However, neither

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Specification, nor recited by the Applicant literature references have succeeded in doing so.

The burden is on the Applicant side to demonstrate that his proposed structure is not a mere result of optimization.

Additionally, even assuming for the sake of argument only, that the Applicant assertion is right and reduction of size to 0.1 micrometers would change the physics of discharge making well known formulas inapplicable, the Examiner should note that dimensional limitations is not a part of any independent Claim 1, 5, 9, or 14, and therefore, even in such conditions, the independent Claims 1, 5, 9 and 14 rejection will remain valid.

6. Applicant's arguments have been fully considered but they are not persuasive.

Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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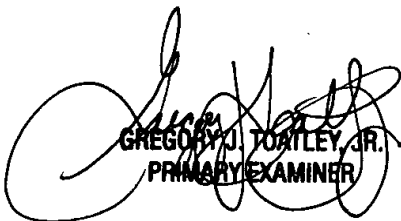
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zeev Kitov whose telephone number is (703) 305-0759. The examiner can normally be reached on 8:00 – 4:30. If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (703) 308-3119. The fax phone numbers for organization where this application or proceedings is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Z.K.
08/15/2003


GREGORY J. TOOLEY, JR.
PRIMARY EXAMINER